

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-5, 7, 8 and 21-27 are now present in this application. Claims 1, 5 and 23 are independent.

Claim 5 is amended to include the subject matter of claim 6, claim 6 is canceled, and claim 27 is added. Support for newly added claim 27 is found, for example, in the last paragraph on page 18 of Applicant's specification. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Allowable Subject Matter

Claims 2, 6 and 24 are indicated as containing allowable subject matter. Applicants have amended claim 5 to include the subject matter of claim 6, thereby placing claims 5, 7 and 8 in allowable form.

Rejection Under 35 U.S.C. §102

Claims 1, 3-5, 7, 8, 21-23, 25 and 26 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,531,392 to Song et al. ("Song"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Initially, Applicants respectfully submit that claim 5, as amended to include the subject matter of claim 6 (that has been indicated as containing allowable subject matter), is allowable, and that dependent claims 7 and 8 are also allowable because they include the subject matter of claim 5, from which they depend.

Further, it is noted that the Office Action does not give patentable weight to the language reciting that the first metal layer is patterned by a dry etching process.

Applicants have amended independent claims 1, 5 and 23 to positively recite a combination of structural features including that the second metal layer is adapted to be a dry etching mask to pattern the first metal layer so that etched side-walls of the first metal layer and the second metal layer are substantially aligned instead of being over-etched when the device is manufactured.

Applicant respectfully submits that claims 1, 5 and 23 positively recite structural features of the second metal layer as a mask to pattern the first metal layer.

In this regard, Applicant refers to the decision by the Court of Customs and Patent Appeals in In re Venezia, 189 USQ 149 (CCPA 1976).

In that case, a number of claims were presented. Claim 31 with emphasis, was representative of the claims on appeal and reads as follows:

31. A splice connector kit having component parts *capable of being assembled* in the field at the terminus of high voltage shielded electrical cables for providing a splice connection between first and second such cables, said cables each having a conductor surrounded by an insulating jacket within a conductive shield wherein a portion of the conductive shield is removed to expose the insulating jacket and a portion of the insulating jacket is removed to expose the conductor at the terminus of the cable, the kit comprising the combination of:

a pair of sleeves of elastomeric material, each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables, each said sleeve having an external surface and a resiliently dilatable internal bore for gripping the insulating jacket to increase the dielectric strength of the creep path along the insulating jacket;

electrical contact means *adapted to be affixed* to the terminus of each exposed conductor for joining the conductors and making an electrical connection therebetween;

a pair of retaining members *adapted to be positioned* respectively between each of said sleeves fitted over the insulating jacket of each said cable and the corresponding terminus of each said cable, said retaining members each having means cooperatively associated therewith for maintaining each said member's position relative to the insulating jacket on each said cable and for precluding axial movement of the sleeve toward the corresponding terminus of each said cable; and

a housing, said housing having an internal bore extending therethrough from end to end, said housing including portions adjacent each end thereof defining said internal bore and being resiliently dilatable *whereby said housing may be slideably positioned* over one of said cables and *then slideably repositioned* over said sleeves, said retaining members, and said contact means *when said sleeves, said retaining members and said contact means are assembled* on said cables as hereinabove, said resiliently dilatable portions of said housing respectively gripping the corresponding external surface of each said sleeve in watertight sealing relationship therewith and said housing having a further portion intermediate its ends defining said internal bore and forming a sealed chamber enclosing at least said contact means and the exposed portions of said cable conductors *when said housing is in its repositioned location.*

The Court reviewed the disputed claims and in particular the language criticized by the Examiner and the Board, and concluded that the claims do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularly, that they are, therefore, definite as required by the second paragraph of section 112. As the Court viewed these claims, they precisely define a group or "kit" of interrelated parts. The Court continued by stating:

These interrelated parts may or may not be later assembled to form a completed connector. But what may or may not happen in the future is *not* a part of the claimed invention. The claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, if assembled. However, this is not to say that there is anything futuristic or conditional in the "kit" of parts itself. For example, paragraph two of claim 31 calls for "a pair of sleeves * * * each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables." Rather than being a mere direction of activities to take place in the future, this

language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to the "adapted to be affixed" and "adapted to be positioned" limitations in the third and fourth paragraphs of the claim. The last paragraph of claim 31 contains additional language criticized by the board, including "may be slideably positioned," "slideably repositioned," "when said sleeves * * * are assembled," and "when said housing is in its repositioned location." However, this language also defines present structures or attributes of the part of the "kit" identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired. Again, a present structural configuration for the housing is defined in accordance with how the housing interrelates with the other structures in the completed assembly. We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly. More particularly, we find nothing indefinite in these claims. One skilled in the art would have no difficulty determining whether or not a particular collection of components infringed the collection of interrelated components defined by these claims. In re Miller, supra.

Applicant respectfully submits that independent claims 1 and 23, by reciting "wherein the second metal layer is adapted to be a dry etching mask to pattern the first metal layer so that etched side-walls of the first metal layer and the second metal layer are substantially aligned instead of being over-etched when the device is manufactured" is positively reciting present structures or attributes of the liquid crystal display device by defining the structures of the components of the completed liquid crystal display device in terms of the interrelationship of the components, or the attributes they must possess, in the completed device, which limits the structure of the liquid

crystal display device to what is recited, e.g., the second metal layer as a dry etching mask to pattern the first metal layer.

Unfortunately, the final Office Action does not respond to this last paragraph on its merits. Instead, the outstanding Office Action dismisses the “In re Venezia” decision as “moot since the examiner has not rejected the claims as being indefinite.”

However, the Advisory Action states that this “adapted to” language has been taken into consideration and is met by Song because Song has structure necessary to allow it to be a dry etching mask. Applicant disagrees for the reasons discussed above and because Song clearly did not appreciate this positively recited features as evidenced by the fact that Song has to use the extra mask elements 300, 400 and 500 to make his product. There is no appreciation by Song that anything other than mask elements 300, 400 and 500 can be adapted to be used as masks. Applicant also disagrees because the Examiner is not treating the “adapted to” language as imparting a structural limitation to the sleeve.

Applicant respectfully submits that this treatment of the quoted language from the “Venezia” decision is completely improper. As pointed out above, the court explicitly stated that not only did the language in issue in the “Venezia” case comply with the requirements of the second paragraph of 37 CFR §112, but also that Venezia’s claimed invention does include structural limitations on

each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, if assembled, and that this is not to say that there is anything futuristic or conditional in the "kit" of parts itself. For example, claim 31's "a pair of sleeves * * * each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables," rather than being a mere direction of activities to take place in the future, was held to impart a structural limitation to the sleeve.

The Court clearly stated that: "[O]n appeal before us are claims drawn to a splice connector 'kit' consisting of the parts which are used in making the splice in their unassembled condition." In deciding what these claims did or did not claim, the Court concluded that: "although the claims before us contain some language which can be labeled 'conditional,' this language, rather than describing activities which may or may not occur, serves to precisely define present structural attributes of interrelated component parts of the "kit," such that a later assembly of the 'kit' of parts may be effected." *Id., at page 152.*

In reaching this decision, the Court noted that each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to the "adapted to be affixed" and "adapted to be positioned" limitations in the third and fourth paragraphs of the claim. The last paragraph of claim 31 contains additional language criticized by the Board, including "may be slideably positioned," "slideably repositioned,"

"when said sleeves * * * are assembled," and "when said housing is in its repositioned location." However, this language also defines present structures or attributes of the part of the "kit" identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired. Again, a present structural configuration for the housing is defined in accordance with how the housing interrelates with the other structures in the completed assembly. We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly.

This holding is concerned with what types of claim language constitute structural limitations, which is an issue in the outstanding rejection, and to dismiss it as moot denies Applicant fundamental substantive and procedural due process to which Applicant is entitled under the Administrative Procedures Act. See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Applicant respectfully submits that by positively reciting that the second metal layer is adapted to be a dry etching mask to pattern the first metal layer so that etched side-walls of the first metal layer and the second metal layer are substantially aligned instead of being over-etched when the device is manufactured, claim 1, for example, is positively reciting a present structural

configuration for the housing. Claim 1 is also defined in accordance with how the housing interrelates with the other structures in the completed assembly by defining the structures of the components of the completed liquid crystal device assembly in terms of the interrelationship of the components, i.e., the first and second metal layers, in the completed liquid crystal device assembly.

Moreover, Song does not anticipate the structural features of claim 1. Song's masks are disclosed as elements 300, 400 and 500, none of which is, for example, a second metal layer adapted to be a dry etching mask to pattern the first metal layer so that etched side-walls of the first metal layer and the second metal layer are substantially aligned instead of being over-etched when the device is manufactured, as recited.

The outstanding Office Action speculates, without providing any objective factual evidence in support thereof, that because the second metal layer is above the first metal layer in Song's Fig. 4, Song's second metal layer is adapted to be a dry etching mask to pattern the first metal layer. Applicant respectfully disagrees because, in fact, the only objective evidence in this rejection is Song, and Song only discloses using separate photomasks, e.g., 300, 400 and 500, none of which is a second metal layer, as recited. Song contains no disclosure or suggestion of a second metal layer adapted to be a dry etching mask to pattern the first metal layer so that etched side-walls of the first metal layer and the second metal layer are substantially aligned

instead of being over-etched when the device is manufactured, as recited. Applicant respectfully submits that Song does not explicitly or inherently (i.e., necessarily, not just possibly or not just probably) disclose its second metal layer adapted to be used as a dry etching mask. In this regard, Applicant respectfully submits that inherency may not be established by probabilities or possibilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

The Office Action also states that, in Song's Fig. 4, the second metal layer is above the first metal layer in a manner such that the second metal layer is capable of (adapted to) being used as a dry etching mask to pattern the first metal layer.

Applicant respectfully disagrees. There is absolutely no disclosure in Song that its second metal layer is adapted to be used as a dry etching mask to pattern the first metal layer. Nor is there any objective factual evidence presented by the Office Action that this disclosure is contained in Song. All that is presented in this regard is speculation unsupported by objective factual evidence. Moreover, as noted above, Song teaches away from using the second metal layer as a dry etching mask for the first metal layer, by using a separate mask.

During patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Applicant respectfully submits that the Office has not made out a *prima facie* case of anticipation of independent claims 1, 5 and 23 at least because it has not made out a *prima facie* case that Song discloses the claimed invention, which includes the second metal layer as a dry etching mask to pattern the first metal layer side-walls of the first metal layer and the second metal layer to be substantially aligned, instead of being over-etched when the device is manufactured.

Claims 3, 4 and 21 depend on claim 1 and, therefore, are patentable at least for the reasons stated with respect to independent claim 1.

As noted above, claims 7, 8 and 22 depend on claim 5 and, therefore, are patentable at least for the reasons stated with respect to independent claim 5.

Claims 25 and 26 depend from claim 23 and, therefore, are patentable at least for the reasons stated with respect to claim 23.

Thus, the device of Song does not anticipate claims 1, 3-5, 7, 8, 21-23, 25 or 26.

Accordingly, reconsideration and withdrawal of this ground of rejection is respectfully requested.

Allowable Subject Matter

Applicant acknowledges with appreciation the indication of allowable subject matter in claims 2, 6 and 24. Applicant has not re-written claims 2, 6 and 24 in independent form, however, because of Applicant's belief that claims 1, 5 and 23, from which claims 2, 6 and 24, respectively, depend, are allowable, for reasons stated above. Claims 2 and 24 have not been re-written in independent form but are allowable for reasons discussed above.

New Claim 27

New claim 27 depends from claim 5 and is allowable at least for the reason that claim 5 is allowable. Claim 27 also is allowable because the applied art does not disclose or suggest the buffer and data metal layer features recited in claim 27.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the

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outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Pursuant to 37 C.F.R. §1.17 and §1.136(a), Applicant respectfully petitions for a two (2) month extension of time for filing a reply in connection with the present application, and the required fee is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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